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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,626	10/11/2001	Robert E. Haines	10007582-1	1665

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

MEUCCI, MICHAEL D

ART UNIT	PAPER NUMBER
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2142

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/976,626

Applicant(s)

HAINES ET AL.

Examiner

Michael D. Meucci

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2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-16, 23 and 25-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-16, 23 and 25-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. This application has been reassigned to Michael Meucci.
2. Claims 1-8, 10-16, 28-23, and 25-35 remain pending.

Specification

3. The specification is objected to because reference character "14" has been used to designate both "hard copy output engine" and "peripheral device" when referring to figure 1. Correction of the specification is required.
4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 21-23, 25, and 26 contain the term "computer usable medium" which is not defined by the specification.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 8 and 10-13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the "device" as a database maintained by the vendor, does not reasonably provide enablement for non-vendor-maintained databases, intermediate transmission media in a network, and other computer systems in which the

signal originates. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Since the claims define the apparatus as a device, any device configured to provide, transmit, or relay a signal (e.g. databases not maintained by the vendor, home computers, gaming consoles, cellular phones, modems, etc.) would embody the applicant's invention as claimed.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 2, 8, and 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 8 and 10-13 define a device that is merely configured to provide instructions. While the instructions may provide utility in some aspect, the "device" lacks structure essential to the apparatus definition. As claimed, the device is embodied by any machine capable of sending instructions (i.e. any message, email, etc.) and is anticipated by any computer, cellular phone, modem, etc. capable of doing the same. The functionality disclosed in the claim pertains only to the intended use of the signal and does not define the device in any way. The claim is so broad in scope that one skilled in the art could not make and use the invention without undue experimentation.

b. Claim 1 recites the limitation "the configuration data" in line 7. There is insufficient antecedent basis for this limitation in the claim.

c. Claim 2 recites the limitation "the hard copy engine" in line 3. There is insufficient antecedent basis for this limitation in the claim.

d. Claim 2 recites the limitation " the configuration data " in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-7 rejected under 35 U.S.C. 103(a) as being unpatentable over Kageyama (U.S. 6,333,790 B1) in view of Ishizuka (U.S. 2002/0065873 A1).

a. Regarding claim 1, Kageyama teaches: receiving an electronic message including hard copy output engine configuration data from an undesignated website, wherein the electronic message designates a hardcopy output engine to be configured; and configuring the hard copy output engine using the configuration data (lines 13-41 of column 3 and lines 33-57 of column 15). Kageyama does not explicitly teach: the electronic message being transmitted through a firewall. However, Ishizuka discloses: "Moreover, alternate servers enable the printer addresses and the associated printer drivers to be stored on servers protected by firewalls and accessible via the LAN 223 (paragraph [0030] on pages 2-3). It would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to transmit the electronic message

through a firewall. Firewalls protect the servers (paragraph [0030] on page 2) by preventing unauthorized access to the servers. It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to transmit the electronic message through a firewall in the system as taught by Kageyama.

b. Regarding claim 2, Kageyama teaches: wherein receiving the electronic message comprises receiving an email at the hard copy output engine and wherein configuring comprises configuring the hard copy engine via an embedded web server contained in the hard copy output engine using the configuration data (lines 13-41 of column 3).

c. Regarding claim 3, Kageyama teaches: wherein receiving the electronic message comprises receiving an email (lines 13-41 of column 3).

d. Regarding claim 4, Kageyama teaches: wherein receiving the electronic message comprises: receiving an email at a first user station (lines 13-41 of column 3); and forwarding the email to the hard copy output engine (lines 31-39 of column 3).

While Kageyama teaches: receiving the email at the first station, Kageyama does not explicitly teach: receiving the email through the firewall at the first station. However, the use of firewalls has been discussed above in regards to claim 1 in which the same reasoning applies.

e. Regarding claim 5, Kageyama teaches: configuring includes setting a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media

consumed (lines 8-21 of column 12). Kageyama does not explicitly teach: wherein receiving the electronic message comprises receiving an XML script. However, Ishizuka discloses: "Thus, when a user has identified information which she wishes to print, and the information is provided on the Internet 102 in an HTML or XML file, then the wireless mobile device 106 transmits the file to the print server 413 which interprets the file and subsequently sends the formatted information to the printer 110," (paragraph [0044] on page 4). It would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to receive the electronic message as an XML script. "HTML and XML are both markup languages. Markup language files include directions that tell browsers how to display a document having graphics and/or text. According to an embodiment of the invention, the print server 413 includes browser software or the like configured to interpret HTML and XML files," (paragraph [0044] on page 4 of Ishizuka). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to receive the electronic message as an XML script in the system as taught by Kageyama.

f. Regarding claim 6, Kageyama teaches: wherein the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers, and printers (lines 50-61 of column 1).

g. Regarding claim 7, Kageyama teaches: wherein the configuration data include data prepared by: determining a make and model for the hard copy output engine (Fig. 10); determining a serial number for the hard copy output engine (Fig. 10);

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and determining user thresholds for consumables associated with the hard copy output engine (lines 8-21 of column 12).

h. Claims 8 and 10-13 contain limitations similar to those disclosed in claims 1-7 and are rejected under the same rationale.

i. Claims 14-16 and 18-20 contain limitations similar to those disclosed in claims 1-7 and are rejected under the same rationale.

j. Claims 21-23, 25, and 26 contain limitations similar to those disclosed in claims 1-7 and are rejected under the same rationale.

k. Claims 27-35 contain limitations similar to those disclosed in claims 1-7 and are rejected under the same rationale.

Response to Arguments

11. Applicant's arguments with respect to claims 1-8, 10-16, 28-23, and 25-35 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gase et al. (U.S. 5,580,177) discloses printer/client network with centrally updated printer drivers and printer status monitoring.

Chang et al. (U.S. 2002/0059415 A1) discloses an output manager capable of communication with, managing, and synchronizing data or software components with output devices.

Pineau (U.S. 2002/0181010 A1) discloses printing remote images using a mobile device and printer.

Engel et al. (U.S. 2002/0198969 A1) discloses configuring network devices with applets.

Picca et al. (U.S. 6,952,731 B1) discloses remote control of devices over the internet including updating and configuring devices.

Cocotis et al. (U.S. 2007/0022180 A1) discloses output management, updating printer drivers, and printing from wireless devices.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Meucci at (571) 272-3892. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell, can be reached at (571) 272-3868. The fax phone number for this Group is 571-273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [michael.meucci@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER